

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

REMARKS

Introduction

Applicants note with appreciation the Examiner's indication that each of the references cited in the Information Disclosure Statement of October 27, 2005 have been considered. However, Applicants respectfully point out that although page 1 of the Office Action mailed December 10, 2008 indicates claims 1-13 and 39 are rejected, the Office Action later states that these claims 40 and 41 are also rejected. Clarification is respectfully requested, nonetheless Applicants respectfully submit that claims 1-13 and 39-41 are allowable for at least the reasons provided below. Furthermore, page 1 of the Office Action indicates claims 1-13 and 39-41 are pending. However, only claim 35 has been cancelled. Withdrawn claims (claims 14-34 and 36-38) remain pending. Clarification is respectfully requested.

Upon entry of the foregoing amendment, claims 1-34 and 36-41 are pending in the application. Claims 14-34 and 36-38 have been withdrawn due to the restriction requirement. However, "the propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder. Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits." (See MPEP §821.04).

No claims have been amended. Claim 42 has been newly added. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are respectfully requested.

Finality of the Next Action Is Precluded

Applicants notes the Office Action mailed December 10, 2008 does not properly reject independent claim 8. Indeed, although the Summary of the Office Action indicates that claim 8 stands rejected, the Detailed Action states claim 8 stands rejected based upon Roosen in view of Shaw, yet omits any explanation on how Shaw renders obvious this claim. Applicants

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

respectfully submit that this omission amounts to a failure to articulate a prima facie case of unpatentability and the burden to rebut this “rejection” has not yet shifted to the Applicants. Consequently, a next Office action rejecting claim 8 cannot properly be made final since only then would the Applicants be given a chance to rebut the rejection, presuming that such an Office action sets forth a prima facie case. (See MPEP § 706.07(a)).

Examiner’s Response to Applicants’ arguments

The Examiner did not find persuasive Applicants’ arguments with regard towards the restriction requirement. More specifically, the Examiner maintained the position that the Species 1 (claims 1-13 and 39-40), Species 2 (claims 14-32), and Species 3 (claims 33-38) are distinct and an examination of all three species would constitute a serious examination and search burden. However, the Examiner found persuasive Applicants’ request for reconsideration; however new grounds of rejection were asserted.

Rejection under 35 USC §103

Claims 1-6, 8-13, and 39-41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/27673 to Roosen et al. (hereinafter “Roosen”) in view of U.S. Patent No. 6,151,598 to Shaw et al. (hereinafter “Shaw”). Applicants respectfully traverse the rejection for at least the following reasons.

Independent claims 1 and 39

Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest each limitation as recited in the claims. More specifically, the Examiner alleges that an external document storage machine 509 and external document processing machine 507 in Shaw could be interpreted to respectively read on Applicants’ “storage unit” and “printing unit.” However, Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest, among other things, “the storage unit is selectively connected to one of the scanning unit and the printing unit,” as recited in claim 1 and similarly recited in claim 39.

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

As stated by the Examiner on page 2 of the Office Action mailed December 10, 2008, "Roosen does not disclose wherein the storage unit is selectively connected to one of the scanning unit and the printing unit." Further, the Examiner alleges that "Shaw discloses wherein the storage unit is selectively connected to one of the scanning unit and the printing unit" since "document entry 503 are used so that the user can selectively connect the storage 509 to either the scanner 158 or printer 154 as clearly disclosed in Col. 7 Lines 30-35." However, the document entry 503 of Shaw is part of a separate and distinct integrated circuit that is not part of the Shaw external document storage machine 509. (Shaw, col. 7, lines 24-35). In other words, the Shaw document entry 503 is part of an intermediary integrated circuit that is separate from the Shaw external document storage machine 509. Further, by definition, the external document storage machine of Shaw is external from the Shaw integrated circuit, as disclosed in columns 7 and 8. Therefore, contrary to Applicants' general inventive concept, the Shaw external document storage machine 509 is not "selectively connected to one of the scanning unit and the printing unit." Rather, the Shaw "document entry 503 selectively connects with plurality of external document storage 509, transmission 511, processing 507, printing or display machines," as recited in column 8, lines 8-10 of Shaw. This distinction between Shaw and Applicants' inventive concept cannot be overlooked since Applicants' selective connection between Applicants' storage unit and one of the scanning unit and printing unit represents a significant aspect of Applicants' general inventive concept. (See Summary of the Invention in Applicants' specification). Thus, Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest, among other things, Applicants' "storage unit is selectively connected to one of the scanning unit and the printing unit," as recited in claim 1 and similarly recited in claim 39.

Independent claim 8

Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest each limitation as recited in the claim. More specifically, the Examiner alleges that a set memory 4 and printer 5 of Roosen could be interpreted to respectively read on Applicants' "storage unit" and "printing unit." However, Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest, among other things, "causing the storage unit to be directly connected to a printing unit," as recited in claim 8. (Emphasis added).

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

The Examiner cites paragraphs [0062] through [0063] as well as FIGS. 1 and 2 of Roosen in order to teach of a connection between Roosen's set memory 4 and printer 5. However, paragraphs [0062] and [0063] as well as the rest of the text of Roosen fail to mention a direct connect between Roosen's set memory 4 and printer 5. Rather, as stated by the Examiner while citing Roosen paragraph [0063], "the generated image data is read out from memory 4 to be printed by Printer 5." (See page 7 of the Office Action mailed December 10, 2008). In other words, a connection between the printer 5 and set memory 4 is stated by Roosen and demonstrated via an arrow in FIG. 2, but Roosen fails to state a "storage unit to be directly connected to a printing unit," as recited in Applicants' claim 8. (Emphasis added). Since Roosen is silent as to a direct connection between Roosen's set memory 4 and printer 5, an intermediary apparatus may, contrary to Applicants' general inventive concept, lay in-between Roosen's set memory 4 and printer 5. This distinction between Roosen and Applicants' inventive concept cannot be overlooked since Applicants' direct connection between Applicants' storage unit and printing unit represents a significant aspect of Applicants' general inventive concept. (See Summary of the Invention in Applicants' specification). Therefore, Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest, among other things, "causing the storage unit to be directly connected to a printing unit," as recited in claim 8.

Independent claims 9 and 13

Applicants respectfully submit that the Examiner's alleged motivation is not supported by the references relied upon. Applicants respectfully submit that contrary to the assertions made by the Examiner, it would not have been obvious to modify the scan and print processing network system of Roosen with the teachings of Shaw directed towards the development of "a internal data structure for representing digital dictionary," which is non-analogous to the art of "a method of digitally processing images in a network system including digital image processing devices provided with operating means and a display," wherein when a selected image processing device in the network cannot process a scan or print job, "the selected device automatically checks if any of the other devices can process the job in accordance with the job settings." (See Roosen, Abstract and Summary of Invention and Shaw, Abstract and col. 3, lines 55-68). In other words, Roosen focuses on a form on interactive printing within a network

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

including multiple digital image processing devices, whereas Shaw is directed towards the software backbone supporting “computing architecture for the optimum run-time performance of processing document related data files.” (Shaw, col. 3, lines 55-60). (Emphasis added.)

As described above, Shaw is non-analogous art and is therefore not applicable to reject Applicants’ general inventive concept as recited in independent claims 9 and 13. Since disqualified Shaw was used to allegedly teach a “plurality of storage units” and the Examiner has admit on page 8 of the Office Action mailed December 10, 2008 that Roosen “does not disclose a plurality of storage units,” Applicants respectfully submit that Roosen in view of Shaw fail to teach or suggest, among other things, Applicants’ “plurality of storage units,” as recited in independent claims 9 and 13.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. (See MPEP 2142) To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the intended function of reference(s) must not be destroyed upon combining or modifying the reference(s). Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. Since for at least the reason that the Examiner has not shown that Roosen in view of Shaw teach or suggest all the features of independent claims 1, 8, 9, 13, and 39, the Examiner therefore has not provided a sufficient factual basis to support a *prima facie* case of obviousness with respect to claims 1, 8, 9, 13, and 39. Accordingly, Applicants respectfully submit that claims 1, 8, 9, 13, and 39 are allowable over Roosen in view of Shaw, and withdrawal of this rejection and allowance of these claims are earnestly solicited.

Dependent claims 2-7, 10-12, 40, and 41

For at least the reason that claims 2-7, 10-12, 40, and 41 depend from independent claims 1, 9, and 39, and therefore contain all of the features recited therein, dependent claims 2-7, 10-12, 40, and 41 are also allowable over Roosen in view of Shaw, for at least the reasons in

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

which independent claims 1, 9, and 39 are allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claims 2-7, 10-12, 40, and 41 are earnestly solicited.

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Roosen in view of Shaw and further in view of U.S. Patent No. 7,019,869 to Chen. Applicants respectfully traverse the rejection for at least the following reasons.

For at least the reason that claim 7 depends from independent claim 1, and therefore contains all of the features recited therein, dependent claim 7 is also allowable over Roosen in view of Shaw and in further view of Chen, for at least the reasons in which independent claim 1 is allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of claim 7 are earnestly solicited.

New Claim

New claim 42 has been added. No new matter is being added, and support for new claim 42 can be found throughout the specification, such as, for example, at paragraphs [0056] through [0071] and FIGS. 5 and 6. Applicants respectfully submit that the prior art of record does not teach or disclose all limitations of new claim 42. In particular, the cited prior art does not show Applicants' "a controller for detecting an attachment state of the external storage unit, and for storing the scanned result in at least one of the external storage unit and an internal storage unit according to the detected attachment state of the external storage unit," as recited in new claim 42. Accordingly, claim 42 is patentable over the cited references and allowance of claim 42 is earnestly solicited.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

Serial No.: 10/673,207
Docket No.: 101-1004
Amendment dated February 2, 2009
Reply to the Office Action of December 10, 2008

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

STANZIONE & KIM, LLP

Dated: February 2, 2009
919 18th St., NW, Suite 440
Washington, DC 20006
Telephone: (202) 775-1900
Facsimile: (202) 775-1901

By: 

Marcus Menezes
Registration No. 62,008